

REMARKS

Applicants have carefully reviewed the Application in light of the Advisory Action mailed September 28, 2005. At the time of the Advisory Action, Claims 1-40 were pending in the Application. Applicants amend Claims 1, 9-11, 13, 16, 23, 30, and 36 and cancel Claims 6, 8, 14-15, and 28 without prejudice or disclaimer. Applicants' amendments and cancellations have been done to advance prosecution in this case and not to overcome prior art. Applicants respectfully request reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1, 3, 8, 10, 16, 22-23, 25, and 30 under 35 U.S.C. §102(e), as being anticipated by U.S. Patent No. 6,304,574 issued to Schoo, et al. (hereinafter "*Schoo*"). Applicants respectfully request reconsideration of this rejection. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (*emphasis added*); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131. *Schoo* does not disclose, teach, or suggest, either expressly or inherently, each and every element of the claims.

Applicants amend Claim 1 to include the limitations of Claim 6; amend Claim 16 to include the limitations of Claim 6; amend Claim 23 to include the limitations of Claim 28; and amend Claim 30 to include the limitations of Claim 6. *Schoo* fails to disclose, teach, or suggest each and every element of Applicants' amended Claim 1, either expressly or inherently. For example, Claim 1 includes "determining whether the protocol capability of the transcoder matches the protocol capability of the station; selecting the transcoder from a plurality of transcoders based on a priority." Because *Schoo* fails to teach at least these limitations, Applicants respectfully submit that *Schoo* cannot anticipate Claim 1 under 35 U.S.C. § 102(e). Thus, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependents.

Independent Claims 16, 23, and 30 each recite certain limitations that, for reasons substantially similar to those discussed with reference to independent Claim 1, are not disclosed, taught, or suggested, either expressly or inherently, by *Schoo*. Therefore, Applicants respectfully request reconsideration and allowance of independent Claims 16, 23, and 30 together with their dependents.

Dependent Claim 10 depends on allowable Claim 36, and is not anticipated by *Schoo* because Claim 10 includes limitations of its respective independent claim and adds additional elements that further distinguish the cited reference. Accordingly, Applicants respectfully request reconsideration and allowance of Claim 10.

Section 103 Rejections

The Examiner rejects Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 under 35 U.S.C. §103(a), as being unpatentable over *Schoo* in view of U.S. Patent No. 6,731,625 issued to Eastep, et al. (hereinafter “*Eastep*”). Applicants respectfully submit that the combination fails to disclose, teach, or suggest the limitations recited in Applicants’ claims.

First, Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 incorporate limitations of their respective independent claims, which Applicants have shown above to be allowable. For at least this reason, Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 are allowable over the prior art.

Second, *Schoo* fails to disclose, teach, or suggest “determining whether the protocol capability of the transcoder matches the protocol capability of the station; selecting the transcoder from a plurality of transcoders based on a priority” as recited in Claim 1. These deficiencies are not cured by combining *Schoo* and *Eastep*. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 2, 4-5, and 7, because they depend from Claim 1, which has been shown to be allowable.

Similarly, independent Claims 16, 23, and 30 incorporate limitations that *Schoo* fails to disclose, teach, or suggest similar to those discussed with reference to independent Claim 1. The combination of *Schoo* and *Eastep* falls short of disclosing, teaching, or suggesting each and every limitation recited in Applicants’ claims. Therefore, Applicants respectfully

request reconsideration and allowance of Claims 17-22, 24-27, 29, and 31-33 because they depend from Claims 16, 23, and 30, which have been shown as allowable.

Applicants amend dependent Claims 9 and 11-13 to depend on allowed Claim 36. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 9 and 11-13.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that Claims 34-40 are allowed. *Office Action*, p. 14. Applicants also note with appreciation the Examiner's indication that Claims 6, 14, 15, and 28 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims. *Office Action*, p. 14. Applicants have incorporated limitations of Claim 6 into Claims 1, 16, and 30 and limitations of Claim 28 into Claim 23. Claim 14 is rewritten in independent form as allowed Claim 36, and the limitations of Claim 15 are included in allowed Claim 37, which depends from Claim 36. Applicants amend dependent Claims 9 and 11-13 to depend on allowed Claim 36. Accordingly, all of the pending claims have been shown to be allowable, and Applicants request reconsideration and allowance of Claims 1-40.


CONCLUSION

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicants respectfully request reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e) and a check in the amount of \$120.00 to cover the one-month extension fee. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicants invite the Examiner to contact its attorney, Barton E. Showalter, at (214) 953-6509.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants



Barton E. Showalter
Reg. No. 38,302

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Customer No. **05073**